

Remarks

The Office Action rejected claims 44 and 45 for allegedly failing to comply with 35 U.S.C. § 101; claims 35-43 for failing to comply with 35 U.S.C. § 112, ¶ 2; claims 1-21, 32, and 46-47 as being allegedly anticipated by or obvious over U.S. Patent Appl. Pub. No. 2005/0055640 ("Alten") and/or secondary references; claims 22-31 and 34-43 as being allegedly obvious over U.S. Patent Appl. Pub. No. 2003/0051255 in view of various secondary references; and claims 33 and 45 as being allegedly anticipated by U.S. Patent 5,543,851 ("Chang").

The Applicants herein cancel claims 32, 44, and 48 and amend claims 1, 8, 9, 22, 33-43, 45, 46, and 49. The amendment to claim 1 clarifies the relation between the "presence sensitive device" and the "display screen," but is not believed to narrow the scope of the claim. Claim 22 is amended to recite additional limitations, to recast "providing the electronic information" as "receiving the electronic information" such that this step is performed at the viewer/user end, and to make other clarifications. Claims 34-43 are amended to correct mistakes in their dependency. Claim 45 is amended to more clearly place it in the form of patent-eligible subject matter. Claim 46 is amended to incorporate the limitations of canceled claim 48 and to re-state one limitation in non-means-plus function form. The other amendments are self-explanatory.

The Applicants believe that all claims are allowable and that the rejections should be withdrawn for at least the following reasons.

§ 101 Rejections

Claims 44 and 45 stand rejected under 35 U.S.C. § 101. Claim 44 is canceled and claim 45 is amended to more clearly put it in a well recognized patent-eligible form drawn to a "computer readable storage medium." See *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995) ("The Commissioner now states 'that computer programs

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embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. §§ 102 and 103.”); see also Eolas Technologies Inc. v. Microsoft Corp., 399 F.3d 1330-31 (Fed. Cir. 2005) (involving a claim drawn to “a computer program product . . . comprising: a computer usable medium having computer readable program code physically embodied therein”); see also Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, Official Gazette (Nov. 22, 2005) (“When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.”). Furthermore, the claim clearly achieves a “useful, tangible, and concrete” result – viz., “show[ing] a meaning of a word.” See id. (citing State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F. 3d 1368, 1373-74 (Fed. Cir. 1998)). The Applicants therefore request that the § 101 rejection of claim 45 be withdrawn.

§ 112, ¶ 2 Rejections

Claims 34-43 stand rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite. As the Examiner kindly noted, these dependent claims mistakenly referred to the wrong claim for dependence. Appropriate corrections have been made, and the Applicants ask that these rejections be withdrawn.

§§ 102 and 103 Rejections Based on Alten

Independent claims 1, 32, 44, and 46 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Alten. Claims 32 and 44 are canceled herein. Claim 1 has been amended for improved clarity, and claim 46 has been amended to incorporate the limitations of claim 48, now canceled. The Applicants respectfully submit that claims 1 and 46 are patentable over Alten for at least the following reasons.

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Alten discloses a remote control unit 18 that can display “enhanced content information.” Specifically, the remote control unit 18 has a small display 20. The primary purpose of the display 20 seems to be to present to the viewer ancillary information on the remote control unit 18 rather than cluttering the television display 17 with that ancillary information. As shown in Figure 1 and described in column 2 (page 1, right side), that ancillary information can include such things as time of day, program identification, and advertisements. When additional ancillary information is available, the remote control 18 can so indicate to the viewer by displaying on the small display 20 an icon (see ¶ [0019]) or a chevron-shaped indicator 25 (see ¶¶ [0024]-[0025]), which may act like a hyperlink.

The small display 20 on the remote control unit 18 may be a touch screen, in which case, the user can initiate a purchase of an advertised item or jump to hyperlinked content by touching the display 20 where the appropriate image is displayed. (See ¶ [0017].) However, Alten’s teaching of touch screens is strictly limited to the small display 20 on the remote control unit 18. Alten does not teach or suggest the use of a touch screen associated with the display 17 of the television receiver 15.

Significantly, Alten’s remote control 20 retains traditional push-type control buttons 24, which seemingly function as expected, e.g., to enter channel selections. Alten does not teach or suggest that a touch screen operation can select a channel for viewing.

Moreover, Alten does not teach that the small display 20 on the remote control unit 18 can act as a television display screen to display television content. While Alten states that “video information” can be displayed on the display screens 17 and 20 (see ¶ [0017], last sentence), the meaning of “video information” in this context is at best ambiguous and most likely refers to generic image data, including still images, motion imagery, animated graphics, flashing graphics, etc. That sole sentence does not imply (let alone teach in an enabling manner) that television motion video signals

can be displayed on the display 20. Similarly, the following sentence (¶ [0018]: "The incoming video information may include television content and enhancement data.") simply means that Alten's overall system receives both television content and enhancement data. That does not mean that television content can be displayed on the display 20. Rather, one skilled in the art would understand Alten's disclosure to mean that the television content is displayed on the large display 17 of the television receiver 15 while some limited-bandwidth "ancillary information" or other "enhancement data" is displayed on the small display 20 of the remote control unit 18. Indeed, the title of Alten's patent application makes this clear: "Displaying Enhanced Content Information on a Remote Control."

Alten does not anticipate claim 1 for at least two reasons. First, claim 1 refers to "a television" that has "a display screen" as well as "a presence sensitive device" that "is operatively disposed in relation to said display screen such that said presence sensitive device senses a presence of an object on or near said display screen." Alten's system, on the contrary, teaches use of a touch screen for the display screen 20 on the remote control unit 18, rather than for the display 17 of the television receiver 15. As explained above, the display screen 20 on the remote control unit 18 is not a television display screen; only the display 17 can display television content.

The second reason that Alten does not anticipate claim 1 is that claim 1 states that "said presence sensitive device is operative to determine a selection of at least one of a plurality of items displayed on said display screen based upon sensing a presence of an object on or near said display screen." However, touching Alten's display 20 does not "determine a selection of at least one of a plurality of items displayed on said [television] display screen." In fact, Alten nowhere suggests that "a plurality items" are "displayed on said [television] display screen" for "selection." Rather, the main objective of Alten seems to be to offload indicia of such choices from the television screen 17 to the remote control unit 18.

The Applicants therefore respectfully request that the rejection of claim 1 based on Alten be withdrawn and claim 1 and its dependent claims 2-21 be allowed.

Claims 6, 8, and 9, which the Office Action also alleges to be anticipated by Alten, are allowable for additional reasons. Claim 6 states that "said presence sensitive device provides an input which emulates a mouse." In rejecting claim 6, the Office Action essentially asserts that anything capable of making selections emulates a mouse. This is not so. This assertion unreasonably interprets the term "emulates." According to this reasoning, everything that flies emulates an airplane. But just as a helicopter is not an airplane, touching images on the display 20 of the remote control unit 18 does not "emulate[] a mouse." The Applicants therefore request withdrawal of the rejection of claim 6.

Claim 8 refers to "a pointing device" and states that "said pointing device provides an interface that can be operated by a person physically impaired from satisfactorily operating push buttons on a remote control." Because claim 8 previously referred to simply "a physically impaired person," the Office Action rejected claim 8 in view of Alten, noting that a person with an amputated leg is "a physically impaired person." (See Office Action at page 6.) Claim 8 has been amended to clearly overcome this rejection.

Claim 9 states that "said presence sensitive device provides an alternate control set for remote control of said television." In rejecting claim 9, the Office Action relied on Alten's control buttons 24. (See Office Action at page 6.) However, those push buttons cannot be the "said presence sensitive device" referred to in claim 6, because, referring back to the base claim 1, "said presence sensitive device is operatively disposed in relation to said display screen such that said presence sensitive device senses a presence of an object on or near said display screen." Alten discloses no touch screen control that "provides an alternate control set for remote control of said television." Accordingly, the Applicants request that the rejection of claim 9 be withdrawn.

Turning to claim 46, which also stands rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Alten, this claim has been amended to read as follows:

46. An apparatus for use with a television displaying an image, said television operating in conjunction with a set top device, said apparatus comprising:
one or more handles;
a screen display;
a touch sensitive input device; and
a communication link to the set top device;
wherein said touch sensitive device is disposed proximately to said screen display in order to allow interaction with a program content being displayed via touching said screen display; and
wherein said screen display displays an image that duplicates the image displayed on said television.

The Office Action contends that Alten's display 20 is a "screen display" as recited in this claim "wherein said screen display displays an image that duplicates the image displayed on said television." To support this contention, the Office Action points to ¶ [0018] of Alten, which states "The incoming video information may include television content and enhancement data." As explained above, that sentence does not mean that television content is displayed on Alten's display 20 on the remote control unit 18. Instead, it means that the television content is displayed on the large display 17 of the television receiver 15 while the enhancement data is displayed on the small display 20 of the remote control unit 18. The rejection of claim 46, and its remaining dependent claim 47, is therefore not sound and should be withdrawn.

§§ 102 Rejection Based on Chang

Claims 33 and 45 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Chang. Claim 33 now refers to "a method for use with an interactive system having a touch screen on which is displayed content including one or more words, comprising: receiving an input comprising a touch on said touch screen; and showing a meaning of a word appearing at a location of said touch." Chang does not teach, disclose, or suggest such use of a touch screen. Claim 45 has been amended

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similarly. According the Applicants ask that the rejections be withdrawn and claims 33 and 45 be allowed.

§§ 103 Rejections Based on Bulman

Independent claims 22 and 34 stand rejected under 35 U.S.C. § 103 as being allegedly obvious over Bulman in view of Hornbuckle and various other secondary references. Bulman (U.S. Patent No. 6,351,265)* discloses a method for creating a personalized picture or videotape having a persons head or face superimposed on another creature.

Claim 22 reads as follows (with emphasis added):

22. A method, comprising:
receiving electronic information in an interactive
format via a television system;
displaying said electronic information, including text
from said electronic information, for viewing by a viewer;
providing a narration of said text substantially
contemporaneously with displaying said text;
receiving payment information for accessing said
electronic information;
wherein said payment comprises a rental charge
for accessing said electronic information;
accepting input other than payment information
from a said viewer; and
modifying said electronic information based on said
input, thereby adapting a result of performing at least one
of the displaying step or the providing step.

* The pertinent Bulman reference is U.S. Patent No. 6,351,265. The reference cited in the Office Action (U.S. Patent Appl. Pub. No. 2003/0051255) is not § 102(e) prior art per se, as it was filed on February 25, 2002 – after the present Applicants' filing date (August 20, 2001). U.S. Patent Appl. Pub. No. 2003/0051255 is a continuation-in-part of the application from which U.S. Patent No. 6,351,265 issued. Any new matter added to the U.S. Patent Appl. Pub. No. 2003/0051255 vis-à-vis U.S. Patent No. 6,351,265 cannot be applied against the present Applicants' claims. Therefore, all references to Bulman herein will be to U.S. Patent No. 6,351,265

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Unlike the process of creating electronic information, as described in Bulman, claim 22 recites steps performed when a viewer views, plays, uses, etc. the electronic information via a television system after that electronic information has been initially created. In fact, claim 22 refers to electronic information being in an "interactive" format and refers to the "accepting input other than payment information from said viewer" and "modifying said electronic information based on said input, thereby adapting a result of performing at least one of the displaying step or the providing step." Bulman, however, does not teach or disclose those steps or any "interactive format." Quite to the contrary, a videotape produced by Bulman's contains a static program that cannot be interacted with. Neither Hornbuckle nor any of the other secondary references cited in the Office Action cure this deficiency in Bulman. The Applicants therefore ask that the rejection of claims 22 and its dependent claims be withdrawn.

The claims depending from claim 22 are patentable over Bulman for additional reasons. For example claim 23 refers to "a plurality of fields" in the "electronic information," wherein "at least one of a plurality of fields is disposed to receive values for identifying characteristics about a viewer." Bulman does not teach or disclose such features when a viewer views, plays, uses, etc. the electronic information post-creation. As another example, claim 25 refers to "taking a picture of a child viewing the electronic information being displayed" and "inserting said picture into a story line with said electronic information being displayed." Bulman does not teach or disclose such features when a viewer views, plays, uses, etc. the electronic information post-creation.

Claim 34 contains limitations similar to claim 22. Claim 34 and its dependent claims 35-43 are allowable for reasons similar to those presented above in regard to claim 22 and its dependent claims.

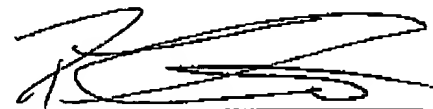
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Conclusion

Because all claims are in condition for allowance, the Applicants respectfully request issuance of a Notice of Allowance. The Examiner is invited to call the undersigned attorney if any issues remain.

Respectfully submitted,

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